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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,299	10/23/2001	Daniel Talbott	SDT-2.001	3244

22874 7590 03/24/2003

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EXAMINER

PATTERSON, MARIE D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 03/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,299

Applicant(s)

TALBOTT, DANIEL

Examiner

Marie Patterson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: there is no basis in the original specification for the plantar surface of the rigid member, i.e. the angular displacement member, to have a concave portion adjacent to a convex portion. There is no language in the specification drawn to such a shape. In the drawings, figures 1-4B, clearly show a rigid member, i.e. the angular displacement member, with only a rounded, convex shape to form the pivot zone, there is no concave portion. Figure 4C may show a slight variance forward of the pivot zone 140'', however it is not clear due to the quality of the drawings and there is no written disclosure directed towards such a shape and also the claims require that the rigid member "terminating distally at a downwardly projecting balance-thrust member" and the balance thrust member (106'') is not considered to be downwardly projecting. It is noted that there are numerous phrases used in the claims which are not present in the specification. It is not clear from the specification what elements applicant is referring to in the claims.

2. The following is a quotation of the first paragraph of 35**U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise,

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and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because the specification fails to provide an adequate written description of the invention, and fails to adequately teach how to make and/or use the invention, i.e. fails to provide an enabling disclosure.

There is no basis in the original specification for the plantar surface of the rigid member, i.e. the angular displacement member, to have a concave portion adjacent to a convex portion. There is no language in the specification drawn to such a shape. In the drawings, figures 1-4B, clearly show a rigid member, i.e. the angular displacement member, with only a rounded, convex shape to form the pivot zone, there is no concave portion. Figure 4C may show a slight variance forward of the pivot zone 140'', however it is not clear due to the quality of the drawings and there is no written disclosure directed towards such a shape

It is noted that the Examiner has assumed that applicant is referring to element 104, i.e. the angular displacement member as the "rigid member" in the claims, however there is no basis in the specification for such. There is no disclosure as to what type of materials element 104 should be made from. There is no element in the specification which is referred to as a "rigid member", nor is there any disclosure of an element

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shaped as claimed, therefore the Examiner is left to assuming what applicant may be referring to in the claims.

Claim Rejections - 35 USC § 112

3. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See above.

4. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 the phrases "the tips" and "the digits", in claim 2 the phrases "the sesamoid apparatus" and "the first metatarsaljoint" lack antecedent basis rendering the claim vague and indefinite. Also, it appears that these phrases are attempting to define the shoe in reference to a foot which is an undefined element which would render the claim vague and indefinite.

In claim 1 the phrase "and an adjacent concave portion....", in claim 2 the phrase "curved angular displacement surface", in claim 3 the phrase "defining a second axis or rotation", claim 4 in its entirety, and in claim 7 the phrases "an adjacent concave portion.... balance-thrust member", "a cuved angular displacement surface..." and "the balance-thrust member..." are confusing, vague, indefinite, and have no basis in the specification and drawings. It is not clear what structural limitations applicant intends to encompass with such language.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Daswick (4348821).

Daswick shows a shoe with a rigid member (10) with convex and concave surfaces (shown in figure 2), a balance thrust portion (front of element 20) and a foot strike member (22) inasmuch as the claims are understood.

7. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Whatley (2002/0026730).

Whatley shows a shoe with a rigid member, ball thrust portion, and foot strike member (34) shaped as claimed (figure 1) inasmuch as the claims are understood.

8. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Alexander (WO 92/14372).

9. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Spronken (4425721).

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Spronken shows a shoe with a rigid member, ball thrust portion, and foot strike member (1) shaped as claimed (figure 2) inasmuch as the claims are understood.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728